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| 10/083,356 | 02/27/2002 | Masahiro Kageyama | H-1037 | 9182 |

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| EXAMINER |
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2154

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,356

Applicant(s)

KAGEYAMA ET AL.

Examiner

Joshua Joo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Office Action Filed on 6/30/2005

1. Claims 1-15 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of copending Application No. #10/083,359. Although the conflicting claims are not identical, they are not patentably distinct from each other.

4. As per claim 1 of the instant application, obtaining a content of interest rendered by media using first and second terminal devices for information exchange connected to a computer network; displaying an image regarding the content on the first and second terminal devices; sending a first information to identify the displayed image and a second information including object information indicated from the displayed image from the first and second terminal devices to a server device connected to the computer network, respectively, across the computer network; and allowing communication messages between the first terminal and the

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second terminal based on the received first and second information by the server device, are all common subjects with claim 5 of application #10/083,359.

5. As per claim 9, a first input unit, a display unit which displays an image regarding content of interest rendered by media; an information acquisition unit which obtains a first information to identify the displayed image and a second information including object information indicated from the displayed image by said first input unit; a second input unit which inputs a message; and a communication unit which transmits said first and second information and message over a network, are all common subjects with claim 4 of application #10/083,359.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2-3, 7, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) As per claim 2, "first target area selected" and "second target area selected" lack proper antecedent basis.
- ii) As per claim 3, "said target area selected" lacks proper antecedent basis.
- iii) As per claim 7, "said target area selected" lacks proper antecedent basis.
- iv) As per claim 10, "said information to identify content" and "said target area selected" lack proper antecedent basis.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 2, 9, 12, and 13 are rejected under 35 U.S.C. 102(e) as being unpatentable by Ilan et al, US Publication #2002/0059184 (Ilan hereinafter).

11. As per claim 1, Ilan teaches the invention as claimed including the method for communicating among users with similar interests. Ilan's teachings comprise of:

obtaining a content of interest rendered by media using first and second terminal devices for information exchange connected to a computer network (Paragraph 0024. Users access web pages.);

displaying an image regarding the content on the first and second terminal devices (Paragraph 0024. Users accesses web pages.);

sending a first information to identify the displayed image (Paragraph 0023; 0027. Col 9, Server receives URL.) and a second information including object information indicated from the displayed image (Paragraph 0023; 0027. Server receives URL, which may be representative of a data object.) from the first and second terminal devices (Paragraph 0022. Users.) to a server device connected to the computer network, respectively, across the computer network (Paragraph 0031. Server compares data objects and keywords.); and

allowing communication messages between the first terminal and the second terminal based on the received first and second information by the server device (Paragraph 0036. Server initiates communication between the first user and second user.).

12. As per claim 2, Ilan teaches the information exchange method as recited in claim 1 wherein:

said first terminal device for information exchange receives or retrieves content of interest and sends first information to identify the content from the content and first target area selected to define a part or all of an object from the content to an information exchange server equipment across the computer network (Paragraph 0027. Server receives data string. Paragraph 0023. Data string is a pointer to a data object, where data string could be an URL.);

said second terminal device for information exchange receives or retrieves content of interest rendered by media and sends second information to identify the content and second target area selected to define a part or all of an object from the content to the information exchange server equipment across the computer network (Paragraph 0022. One or more users sharing interest in the same subject area. Paragraph 0023. Data string is a pointer to a data object, where data string could be an URL.);

the information exchange server equipment makes up a group of said first and second terminal devices for information exchange, according to a grouping method using said first and second information to identify the content that it received (Paragraph 0029; 0036. Server initiates communication between the first user and the second user based on received information.);

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the first terminal device for information exchange sends a first message to said information exchange server equipment across the computer network (Paragraph 0029. Server provides a communication channel between the first and second user.);

said information exchange server equipment sends said first message that it received to one or more terminal devices for information exchange belonging to said group and including said second terminal device for information exchange across the computer network (Paragraph 0029. Server provides a communication channel between the first and second user.); and

said second terminal device for information exchange receives and outputs said message (Paragraph 0029. Server provides a communication channel between the first and second user.).

13. As per claim 9, Ilan teaches the invention as claimed including the method for communicating among users with similar interests. Ilan's teachings comprise of:

a first input unit (Paragraph 0023-0024. Accesses web page.);

a display unit which displays an image regarding content of interest rendered by media Paragraph 0023-0024. Accesses web page.);

an information acquisition unit which obtains a first information to identify the displayed image and a second information including object information indicated from the display image by said first input unit (Paragraph 0023. Data string representing a data object. Web page.);

a second input unit which inputs a message (Paragraph 0036. Users communicate with other users.); and

a communication unit which transmits said first and second information and message over a network (Paragraph 0027. Server receives data string, which is representative of a data object. Paragraph 0036. Users communicate with other users.).

14. As per claim 12, Ilan teaches the information exchange method according to claim 1, said server device allow communication messages between the first terminal and the second terminal based on consistency between said first and second information from the said first terminal device and said first and second information from said second terminal device (Paragraph 0036. Server initiates communication between the users if a similarity or identify is detected between the data strings.).

15. As per claim 13, Ilan teaches the information exchange method according to claim 12, said communication messages between the first terminal and the second terminal includes chat using said computer network (Paragraph 0029. User communicate with each other. Paragraph 0002-0003. Chat.)

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ilan, in view of Inala et al, US Publication #2003/0014489 (Inala hereinafter).

18. As per claim 3, Ilan teaches the information exchange method as recited in claim 2 wherein said grouping method comprises one of or a combination of a plurality of the following:

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grouping terminal devices for information exchange for which matching to a certain extent occurs regarding said information to identify the content received therefrom (Paragraph 0023; 0036. Server initials communication between users based on similarity or identity of data strings, URL.);

grouping terminal devices for information exchange for which matching to a certain extent occurs regarding said information to identify the content and said target area selected, received therefrom (Paragraph 0031; 0036. Server initials communication between users based on data strings and comparison between contents of data objects.);

grouping terminal devices for information exchange for which matching occurs in one of or a plurality of items of information designating appointed identifiers of terminal devices for information exchange, geographical area, interests, content titles, and community respectively (Paragraph 0022. Users communicate based on interest.).

19. However, Ilan does not teach of grouping terminal devices for information exchange by limiting the number of terminal devices to form a group to a given number.

20. Inala teaches of setting a predetermined maximum number of clients that may define a full chat room (Paragraph 0079).

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan and Inala because both teachings are similar in that users communicate with each other based on commonly visited web sites. Furthermore, the teachings of Inala to limit the number of the users to form a group would improve the teachings of Ilan by preventing groups from becoming too congested with users and allowing administrative control of the groups.

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22. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilan, in view of Emens et al, US Patent #6,745,178 (Emens hereinafter).

23. As per claim 4, Ilan teaches substantially the invention as claimed including the method for communicating among users with similar interests. Ilan's teachings comprise of:

- obtaining a content of interest rendered by media using a first terminal device for information exchange connected to a computer network (Paragraph 0023-0024. Access a web page.);

- displaying an image regarding the content on the first terminal device (Paragraph 0023-0024. Access a web page. Pointer to data object.);

- sending a first information to identify the displayed image (Paragraph 0023. URL.), a second information including object information indicated from the displayed image (Paragraph 0023; 0031. Data objects.), and a message from the first terminal device to an information exchange server equipment across a computer network (Paragraph 0029. User communicates with other users, where server provides communication channel.);

- making up a group of two or more terminal devices including at least the first terminal device and a second terminal device by the information exchange server equipment (Paragraph 0022; 0029; 0036. Server initiates communication with users with similar interests.);

- sending the message received by the information exchange server equipment to the second terminal belonging to said group across the computer network (Paragraph 0029. User communicates with other users through the server.);

- receiving the message from the information exchange server equipment by the second terminal device (Paragraph 0029. User communicates with other users through the server.); and

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displaying the message on the second information device based on the received first and second information and the message (Paragraph 0029. User communicates with other users through the server.).

24. Ilan teaches of a user communicating with another user based on similar interests. However, Ilan does not teach of sending the first information and the second information received by the information exchange server equipment to the second terminal belonging to said group across the computer network; receiving the first and second information from the information exchange server equipment by the second terminal device; and displaying the image on the second information device based on the received first and second information and the message.

25. Emens teaches of identifying users with similar interests, where users may exchange information such as URI (Col 8, lines 61-63.)

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan and Emens because both teachings deal with exchanging messages between users with similar interests. Furthermore, the teachings of Emens to exchange information such as URIs with other users would improve the capability of Ilan's teachings by allowing users to exchange content that have been identified by individual users as taught by Emens.

27. As per claim 5, Ilan does not teach an information exchange method as recited in claim 4, wherein said information exchange server equipment makes up a group of terminals devices for information exchange having a group identifier registered beforehand.

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28. Emens teaches of having a group identifier registered beforehand, where a user may join a preexisting chat groups (Fig. 6B; Col 8, lines 30-36).

29. It would have been obvious to one of ordinary skill in the art the time the invention was made to combine the teachings of Ilan and Emens because the teachings of Emens to having a group identifier registered beforehand would improve the teachings of Ilan by allowing users to join existing chat groups based on the group identifiers.

30. As per claim 6, Ilan teaches of a server initiating communication between users with similar interests. However, Ilan does not teach the information exchange method as recited in claim 4 wherein said information exchange server equipment makes up a group of terminal devices for information exchange in such a way in which:

said server equipment makes a list of one or more groups that have been made up and related information (which will be referred as group information hereinafter) and sends the group list to the first terminal device for information exchange across the computer network;

said first terminal device for information exchange receives and outputs the group list, selects the group information for one group from the group list, and sends the selected group information to the server equipment across the computer network; and

the server equipment sets the first terminal device to join the group appointed by the selected group information.

31. Emen teaches said server equipment makes a list of one or more groups that have been made up and related information (which will be referred as group information hereinafter) and sends the group list to the first terminal device for information exchange across the computer network (Col 8, lines 32-33. User receives a list of chat groups.);

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said first terminal device for information exchange receives and outputs the group list, selects the group information for one group from the group list, and sends the selected group information to the server equipment across the computer network (Col 8, lines 31-37. User selects a group to join.); and

the server equipment sets the first terminal device to join the group appointed by the selected group information (Col 8, lines 38-39. User is placed in the selected chat room.).

32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan and Emens because both teachings deal with matching users with similar interests and allowing communication between the users, where interests may be certain web pages. Furthermore, the teachings of Emens to perform the functions of Paragraph 31 would improve the teachings of Ilan because while Ilan merely teachings of initiating communication with users, Emens teachings would provide the user with the option of joining a desired chat group from a plurality of chat groups that have similar interests with the user.

33. As per claim 7, Ilan does not teach the information exchange method as recited in claim 6 wherein said group information includes said information to identify the content and said target area selected.

34. Emens teaches of group information that contain information to identify the content and the selected content (Fig. 6B; Col 8, lines 31-35).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan and Emens because the teachings of Emens for the group information to contain information to identify the content and the selected content would

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improve the teachings of Ilan by allowing the user to select a chat session that is most relevant to the user's interest.

36. As per claim 8, Ilan and Emens taught the information exchange method as recited in claim 4. Ilan further teachings the method wherein said message comprises one of or a combination of a plurality of following items: character strings of text and keywords, audio information, video information, advertising information, time information, thumbnail images, and pointer information (Paragraph 0023. Data strings such as URLs.).

37. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ilan, in view of Wang et al, US Patent #6,058,428 (Wang hereinafter).

38. As per claim 10, Ilan does not teach a terminal device for information exchange as recited in claim 9 further comprising means for storing said content of interest; and means for generating and displaying a thumbnail image from said information to identify the content, said target area selected, and said content of interest stored.

39. Wang teaches of information exchange, where images are stored on digital acquisition device and a server (Col 5, lines 17-19), and Wang also teaches of generating and displaying a thumbnail image with a link to the original image (Col 5, lines 1-10).

40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teachings of Ilan and Wang because Ilan teaches of accessing web pages with data objects. Wang also teaches of accessing web pages with data objects, where the data objects are thumbnails of images (Col 5, lines 21-23.). Therefore, the teachings of Wang

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to store images; and generating and displaying a thumbnail image with a link to the image would improve the teachings of Ilan by allowing users to communicate with similar interests, where similar interests may be images.

41. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ilan, in view of McGee III et al, US Publication #2002/0104088 (McGee hereinafter), and Yoneda, US Patent #6,002,832.

42. As per claim 11, Ilan does not teach of a terminal device for information exchange as recited in claim 9 further comprising time shifting means for recording and reproducing said contents of interest.

43. McGee teaches of selecting a video image or video segments from web pages (Paragraph 0039).

44. Yoneda teaches of recording and reproducing data, where time shifting is used to record and reproduce videos (Col 7, lines 29-36; Col 8, lines 10-24).

45. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan, McGee, and Yoneda because Ilan and McGee teach of selecting data objects in web pages to find similar data objects, where McGee teaches that the data objects may be video images or video segments. Therefore, the teachings of Yoneda to use time shifting to record and reproduce videos would improve the system of Ilan and McGee by allowing users to record and reproduce videos as contents of interest.

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46. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ilan, in view of McGee.

47. As per claim 14, Ilan teaches that the displayed image may be a data object on a web page (Paragraph 0023). However, Ilan does not specifically teach that the displayed image regarding the content is a video image.

48. McGee teaches of identifying and matching displayed images, where a web page may contain a video image which can be used to match other video images (Paragraph 0039).

49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ilan and McGee because both teachings are similar in that they deal with identifying and matching data objects on web pages. The only difference between Ilan and McGee is that Ilan teaches of identifying and matching with other users, while McGee teaches of identifying and matching with a server. However, the teachings of McGee to have the displayed image regarding the content to be a video image would improve the capability of Ilan's teachings by allowing users to locate other users with similar interests, where the interests maybe specific to an image on a web page.

50. As per claim 15, Ilan teaches of selecting a data object from a web page (Paragraph 0031). However, Ilan does not specifically teach of said object information includes area information indicated from the displayed image by using a pointing device.

51. McGee teaches of selecting video images from a web page by using the video images as a "key image" to identify and match similar images (Paragraph 0039).

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52. Even though, Ilan and McGee do not specifically teach of a pointing device, it would have been obvious to one of ordinary skill in the art that a user may use a mouse to select and/or view an image on a web page. Therefore, the selected and/or viewed data object, i.e. image, may be used to compare and match for similar data objects with other users. The teachings of McGee for the data object to be specifically an image would improve the teachings of Ilan by allowing users to locate other users with similar interests, where interests may be interest in similar images on the Internet.

Conclusion

53. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

54. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- i) Grefenstette et al, US Patent #6,446,035, teaches of grouping users by analyzing browsing behaviors, where analyzable content maybe image data defining images.

55. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


56. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 7 to 4.

57. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

58. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 16, 2005

JJ


ZARNI MAUNG
ASSISTANT PATENT EXAMINER